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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91189418
Party	Defendant Phoenix 2008 LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Application Serial Nos.:	77476098 77497086 77476107 77478035
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Speed Channel, Inc.

Opposer,

v.

Phoenix 2008 LLC,

Applicant.

Opposition No. 91189418

**REPLY TO SPEED CHANNEL, INC.’S OPPOSITION TO PHOENIX 2008 LLC’S
MOTION FOR LEAVE TO FILE (1) MOTION TO STRIKE, OR IN THE
ALTERNATIVE, (2) RESPONSE TO A NEW ISSUE RAISED BY SPEED CHANNEL,
INC.’S REPLY**

Phoenix 2008 LLC (“Applicant” or “Phoenix”) respectfully submits this reply to Speed Channel, Inc.’s (“Opposer” or “Speed Channel”) “Opposition to Phoenix 2008 LLC’s Motion for Leave to File (1) Motion to Strike, or in the Alternative, (2) Response to a New Issue Raised by Speed Channel, Inc.’s Reply” (the “Opposition”).

Opposer asks the Board to refuse to consider, or otherwise deny, Applicant's recent filing, in which Applicant sought leave of the Board to file a motion to strike or, in the alternative, respond to a new issue that Opposer raised for the first time in its reply to Applicant's response to the original motion that initiated this present discovery dispute before the Board (collectively, Applicant's "Motion to Strike"). However, the Opposition does not actually dispute the arguments made by Applicant in its Motion to Strike. To the contrary, the Opposition in fact *supports* the Motion to Strike. Specifically, Opposer agrees with the Motion to Strike that the issue in question – the appropriateness of redactions made by Applicant to certain documents provided to Opposer – is not germane to the Motion to Compel and, therefore, should not be considered by the Board at this time in the context of Opposer's Motion to Compel. Consequently, as demonstrated in Applicant's Motion to Strike, the Board should strike all matter in Opposer's Reply that is related to the redactions made by Applicant to the Redacted Documents.

I. Background

As explained more fully in Applicant's Motion to Strike, on September 28, 2009, Opposer filed a "Motion to (1) Compel Applicant's Responses to Speed Channel's First Set of Requests for Production of Documents and its First Set of Interrogatories; (2) Test the Sufficiency of Applicant's Responses to Speed Channel's Requests for Admissions; and (3) Suspend" (collectively, Opposer's "Motion to Compel"). The Motion to Compel was directed to Applicant's responses to Opposer's initial discovery requests, which consisted of Opposer's first set of requests for production of documents, first set of interrogatories, and requests for admissions.

On November 2, 2009, Applicant supplemented its discovery responses and provided documents to Opposer, pursuant to its duty to supplement under federal law and Board rules. Some of the documents produced by Applicant were designated as “Trade Secrets/Commercially Sensitive” (hereinafter referred to as the “Redacted Documents”). As explained in the Motion to Strike, the Redacted Documents contain critical confidential trade secrets and commercially sensitive information – including financial projections, business strategies and the identities of key business partners and customers – that are fundamental to Applicant’s core business, as well as to its business relationships identified throughout the Redacted Documents. Also on November 2, Applicant timely filed its response to the Motion to Compel, demonstrating, among other things, that the Motion to Compel exceeded the Board’s strict page limit for motion briefs, and that the Motion to Compel was moot in light of Applicant’s supplemental responses and production of documents.

On November 23, 2009, Opposer filed its reply to Applicant’s response to the Motion to Compel (Opposer’s “Reply”). The Reply was unremarkable except for the fact that the Reply introduced, for the first time in this proceeding, an argument that the redactions made by Applicant to the Redacted Documents were “inappropriate,” and a related request for a Board order compelling Applicant to produce fully unredacted versions of the Redacted Documents.

On December 5, 2009, Applicant filed its Motion to Strike, arguing, among other things, that Opposer’s objections to Applicant’s redactions were not germane to the Motion to Compel, and, accordingly, to request that the Board disregard such arguments, as is the Board’s practice. Opposer filed its Opposition in response to the Motion to Strike on December 28, 2009.¹

¹ The Certificate of Service certifies that the Opposition was mailed to Applicant’s counsel on September 28, 2009. For purposes of this response, Applicant assumes that the Certificate of Service was intended to indicate that the Opposition was mailed on December 28, 2009.

II. THE BOARD SHOULD GRANT APPLICANT’S MOTION TO STRIKE BECAUSE THE OPPOSITION SUPPORTS APPLICANT’S POSITION THAT REDACTIONS TO THE REDACTED DOCUMENTS IS NOT A GERMANE ISSUE TO THE MOTION TO COMPEL

The Opposition argues that the Board should deny Applicant’s Motion to Strike because it “devotes substantially all of its attention to addressing [Applicant’s] unilateral decision to redact portions of its supplemental responses to Speed Channel’s Discovery Requests,” which, Opposer argues, “is not germane to Speed Channel’s Motion to Compel.” Opposition at 10-11. However, this is essentially what Applicant’s Motion to Strike argued in the first place – that the issue of Applicant’s redactions to the Redacted Documents, as discussed in Opposer’s Reply, is not germane to the Motion to Compel. Given that Opposer has effectively conceded the point, the Board should grant Applicant’s Motion to Strike.

Indeed, the Opposition itself concedes that the only matters germane to the Motion to Compel relate to Applicant’s responses to Opposer’s initial discovery requests. *See* Opposition at 10-11 (maintaining that the “Motion to Compel is directed towards the deficiencies in Applicant’s Responses to Speed Channel’s Discovery Requests” and that “the Board should consider Applicant’s failure to comply with its discovery obligations as the germane issues [sic] presented in Speed Channel’s Motion to Compel”). Consequently, any issue arising thereafter cannot be germane to the Motion to Compel, including issues related to the Redacted Documents, since, as noted by Opposer, such issues “arose **after** Speed Channel filed its Motion to Compel.” Opposition at 10-11 (emphasis in original).

In reading the Opposition, it becomes clear that Opposer wants the Board to accept Opposer’s objections to Applicant’s redactions, while at the same time, reject Applicant’s response to those objections. But Opposer cannot have it both ways; if the Board finds that Applicant’s Motion to Strike, which was limited to the issue of Applicant’s redactions, is not

germane to the Motion to Compel, it must necessarily find that Opposer's Reply, to the extent it discusses the issue, is also not germane to the Motion to Compel. Accordingly, the Board should grant the Motion to Strike, and disregard all matter in Opposer's Reply that is related to the redactions made by Applicant to the Redacted Documents.

III. THE MOTION TO STRIKE IS NOT A SUR-REPLY BUT, RATHER, A RESPONSIVE PLEADING TO AN ISSUE RAISED FOR THE FIRST TIME OUTSIDE THE SCOPE OF THE ORIGINAL MOTION TO COMPEL

The Opposition further contends that the Board should deny the Motion to Strike because it is an "impermissible attempt to file a Sur-Reply Brief." Opposition at 12. To the contrary, the Motion to Strike was not a sur-reply, but a necessary response to what amounted to a new issue raised by Opposer in its Reply – an objection to Applicant's redactions and a request for an order compelling Applicant to provide fully unredacted confidential documents to Opposer's counsel and, ultimately, to Speed Channel. As explained in the Motion to Strike, to not grant Applicant an opportunity to respond to Opposer's new argument would deny Applicant its due process rights. *See* Motion to Strike at 4-5.

In fact, Opposer is simply incorrect that the Motion to Strike is "precisely the type of sur-reply brief that the Board prohibits." Opposition at 12. Specifically, the Opposition claims that "Applicant seeks to address issues that it could have raised when it responded to Speed Channel's Motion to Compel, but did not." Opposition at 12. However, it would have been both premature and inappropriate for Applicant to have raised the issue in its response, as such matter would have gone beyond the scope of the issues framed by the Motion to Compel – a point that Opposer concedes throughout its Opposition.

Moreover, it was Opposer – not Applicant – who first injected the redaction issue into this discovery proceeding. Thus, while Opposer may claim that the Motion to Strike is not

germane to the present proceeding, Opposer arguably made it so when it discussed the redactions in its Reply. Accordingly, Applicant's Motion to Strike was not an attempt to present new matter on sur-reply, but a necessary response to new matter presented by Opposer for the first time in its Reply.

IV. Opposer Does Not Contest The Appropriateness of Applicant's Redactions to the Redacted Documents

If the Board decides to consider the redaction issue at this time, it should find that the redactions are entirely appropriate and justified. As discussed at length in the Motion to Strike, the redactions are reasonable given the nature of the Redacted Documents and the circumstances in which they were produced. Moreover, the redactions are justified given Opposer's recent indication that it does not intend to comply with the terms of the Standardized Order, including the return of all confidential materials following the conclusion of this proceeding. *See* Motion to Strike at 7-16.

Significantly, the Opposition does not even suggest that Opposer will fully comply with the Standardized Order, and to date, Opposer has not yet given Applicant or its counsel any indication that it intends to do so. The Board simply must not allow Opposer to use discovery, as it obviously intends, as a means of gaining access to, and making post-proceeding use of, Applicant's highly sensitive trade secret information.

WHEREFORE, Applicant respectfully requests that the Board grant its Motion to Strike, as Opposer has presented no argument to the contrary, and, in fact, concedes that the basis for the Motion to Strike – that the issue of Applicant's redactions to the Redacted Documents is not germane to the Motion to Compel – is correct. Applicant further requests that the Board find that its redactions are appropriate and justified, as Opposer has failed to contest the

appropriateness of Applicant's redactions or demonstrate any showing of need to gain access to Applicant's highly sensitive trade secrets and confidential information.

Respectfully submitted,

By:

A handwritten signature in black ink, appearing to read "B. Hurh", written over a horizontal line.

Brian J. Hurh

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January 19, 2010

CERTIFICATE OF SERVICE

I do hereby certify that a copy of the foregoing “Reply to Speed Channel Inc.’s Opposition to Phoenix 2008 LLC’s Motion for Leave to File (1) Motion to Strike, or in the Alternative, (2) Response to a New Issue Raised by Speed Channel, Inc.’s Reply” was sent on via first-class mail on January 19th, 2010 to:

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